

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 16

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BEAT A. VON WEISSENFLUH and GIANNI BAFFELLI

Appeal No. 98-2888
Application No. 29/044,927¹

ON BRIEF

Before McCANDLISH, *Senior Administrative Patent Judge*, ABRAMS
and NASE, *Administrative Patent Judges*.

ABRAMS, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ Application for patent filed October 3, 1995.
According to appellants, this application is a continuation-in-part of Application 29/022,231 filed March 17, 1994, now abandoned.

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This is an appeal from the final rejection of the following design claim:

The ornamental design for a combined abrasive disk and spindle for dental use, as shown and described.

The design is depicted in front and rear perspective views (Figures 1 and 2), in rear, front and side elevational views (Figures 3-5), and in bottom and top plan views (Figures 6 and 7).

THE REFERENCES

The references applied by the examiner are:

Wooster	534,540	Feb. 19,
1895		
DuBe et al. (DuBe)	4,988,294	Jan. 29,
1991		

THE REJECTION

The design claim stands rejected under 35 U.S.C. § 103 as being unpatentable over Wooster in view of DuBe.

The rejection is explained in the Examiner's Answer (Paper No. 12).

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The viewpoints of the appellants are set forth in the Brief (Paper No. 11).

OPINION

The appellants' design is for combined abrasive disk and spindle for dental use. As best seen in Figures 5-7, the design has a handle having portions of two different diameters and ending in an angled disk holding portion that holds an enlarged disk. As can be seen in Figures 2 and 3, the abrasive disk has a square aperture with a single rectangular slit extending across its width.

We begin our analysis by pointing out that the standard for evaluating the patentability of a design is whether it would have been obvious to a designer of ordinary skill in the art involved. See *In re Nalbandian*, 661 F.2d 1214, 1216, 211 USPQ 782, 784 (CCPA 1981). In rejecting a claim to an ornamental design under 35 U.S.C. § 103, the examiner must supply a basic design reference that bears a substantially identical visual appearance to the claimed design. *In re Harvey*, 12 F.3d 1061, 1063, 29 USPQ2d 347, 349 (Fed Cir. 1993). That is, there must be a reference, a something in

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existence, the design characteristics of which are basically the same as the claimed design; once a reference meets this test, reference features may reasonably be interchanged with or added from those in other pertinent references. *In re Rosen*, 673 F.2d 388, 391, 213 USPQ 347, 350 (CCPA 1982).

The essence of the examiner's rejection is that Wooster is a *Rosen* reference, that is, the device disclosed in Wooster has design characteristics which are basically the same as the claimed design, and that a designer of ordinary skill in these articles would have found it obvious to alter the sleeve and the head that holds the disk in such a fashion as to render the claimed design obvious, in view of the showing of DuBe. The appellants argue that Wooster is not a *Rosen* reference and, even if it were, the references are not so related as to have suggested application of the DuBe features to the Wooster design. They also urge that the design resulting from combining the two references would lack some of the features of the claimed design.

We find ourselves in agreement with the appellants that Wooster does not constitute a *Rosen* reference in view of the

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several distinct differences between it and the claimed design. As the appellants have pointed out, the Wooster dental disk holder has two sleeves (6 and 8) mounted on the handle (1), with all three components being of different diameters, as opposed to the single sleeve on the handle of the claimed design. In addition, the Wooster design includes a disk (6a) on the distal end of the sleeve, which is not present in the claimed design, and its disk holding portion (2) is bowl-shaped, as opposed to the angular one of the claimed design. In our opinion, these differences cause the design characteristics of the Wooster dental disk holder not to be basically the same as the claimed design.

Moreover, even assuming, *arguendo*, that Wooster were considered to be a *Rosen* reference, it is our view that the teachings of the two references would not have suggested the application of the features of DuBe to the Wooster design, for to do so would require wholesale revision of the Wooster design. One of the two sleeves would have to be discarded, along with the annular disk. And, the curved disk support would have to be replaced with one having an angular

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configuration, which is not even shown in the DuBe design, since DuBe has no comparable component. Finally, we do not agree with the examiner that the square aperture with central slit provided on the distal end of the disk holder is a *de minimis* difference which does not affect the overall appearance of the design (see Figure 2).

The rejection is not sustained.

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The decision of the examiner is reversed.

REVERSED

HARRISON E. McCANDLISH, Senior)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
NEAL E. ABRAMS)	APPEALS
Administrative Patent Judge)	AND
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JEFFREY V. NASE)	
Administrative Patent Judge)	

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